

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-12 are pending in the present application. Claims 1-12 are maintained by the present amendment.

In the outstanding Office Action, Claims 5-12 were withdrawn from consideration and Claims 1-4 were rejected under 35 U.S.C. § 101.

Applicant thanks the Examiner for the courtesy of an interview extended to Applicant's representative on January 5, 2003. During the interview the pending claims were discussed. No agreement was reached pending the Examiner's further review of a filed response.

Claims 1-4 were rejected under 35 U.S.C. § 101. That rejection is respectfully traversed.

The outstanding Office Action states at page 5, lines 11-13, that the "present invention does not qualify as a patentable invention because it is merely an abstract concept/idea of environmental preservation."

Applicant respectfully submits that Claim 1 recites a *method* for collecting semiconductor devices provided on a printed board, the method including providing predetermined information on a package surface of the semiconductor device which faces the printed board, dismounting the semiconductor device from the printed board such that the predetermined information can be seen and receiving a report based on the predetermined information from the user, and collecting the separated semiconductor device.

Applicant notes that MPEP § 706.03(a) states that patents are granted "only for 'any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.'" In addition, MPEP states under the same section that the

“term ‘process’ as defined in 35 U.S.C. § 100, means process, art or method.” Therefore, the claimed method satisfy the requirements of 35 U.S.C. § 101.

Further, MPEP § 2106 IV A states that “[t]he subject matter courts have found to be outside the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena” and the outstanding Office Action at page 5, lines 11-13, asserts that the present invention “is merely an abstract concept/idea.”

The court in *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), addressed a patent including claims directed to “a method and apparatus for controlling the motion of objects and machines, such as robotic machines, to avoid collision with other moving or fixed objects.” *Warmerdam*, 33 F.3d at 1355, 31 USPQ2d at 1755. That court stated that the steps of a claim that recites “‘locating’ a medial axis, and ‘creating’ a bubble hierarchy” “describe nothing more than the manipulation of basic mathematical constructs, the paradigmatic ‘abstract idea.’” *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. However, the claimed method steps here recite, *inter alia*, providing information on semiconductor devices, dismounting a semiconductor device from a printed board, and collecting the separated semiconductor device. None of these steps involves the manipulation of basic mathematical constructs to satisfy the requirement for an “abstract idea” defined in *Warmerdam*.

Moreover, MPEP § 2106 II A makes it clear that the practical application of a claimed invention, i.e., what it accomplishes in terms of a “useful, concrete and tangible result,”¹ is what differentiates patentable subject matter under 35 U.S.C. § 101 from “subject matter that represents nothing more than an idea or concept.” The “real world” value requirement discussed in this section is clearly met by the present invention that is far more than a mere

¹ *State Street Bank & Trust, v. Signature Financial Group, Inc.* 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998).

idea. See the specification at page 4, lines 8-13, for example, and note that MPEP § 2106 II requires that PTO personnel must “review the complete specification, including the detailed description of the invention, any specific embodiments that have been disclosed, the claims and any specific, substantial, and credible utilities that have been asserted for the invention” relative to such a practical application that establishes the required “useful, concrete and tangible” result.

Accordingly, it is respectfully submitted that the subject matter of the present invention is not an abstract idea as asserted in the outstanding Office Action as it has the requisite practical application in terms of producing a “useful, concrete and tangible result” as noted above.

Regarding the “technological arts” analysis considered by the Court in *In re Toma*, 197 USPQ 852 (CCPA 1975), cited in the outstanding Office Action at page 3, first full paragraph, the Court applied that analysis only to the computer-related invention before it and did not say that all “useful” arts of a process nature had to be computer implemented or that claims directed to a semiconductor device collecting method are not “drawn to any technology.” Further, nothing in any of the cited cases indicates that a claim including manual acts is non-statutory *per se*.

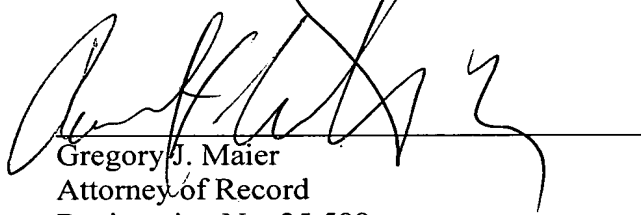
Moreover, the MPEP § 2106 II A requirement for the rejection to include an express statement of “how the language of the claims has been interpreted to support the rejection” is lacking.

Accordingly, it is respectfully submitted that the subject matter of the present invention qualifies as a patentable invention under 35 U.S.C. § 101 because the subject matter is directed to specific method steps including manipulating semiconductor devices and not to an abstract idea or concept. It is further submitted that the outstanding rejection should be withdrawn as failing to meet the requirements of MPEP § 2106 noted above.

Consequently, in light of the above discussion the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Gregory J. Maier', is written over a horizontal line.

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